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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,346	11/08/2001	John Lawrence Bowers	P64258US2	8502

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EXAMINER

RIVELL, JOHN A

ART UNIT	PAPER NUMBER
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3753

DATE MAILED: 10/04/2004

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/986,346

Applicant(s)

BOWERS, JOHN LAWRENCE

Examiner

John Rivell

Art Unit

3753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/20/03 (amendment).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16,17,19-25,41,43-47,49-54,64,66-70 and 72-121 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16,17,19-25,41,43-47,49-54,64,66-70 and 72-121 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's arguments filed October 20, 2003 have been fully considered but they are not persuasive.

As a result of the response filed October 20, 2003, claims 1-15, 18, 26-40, 42, 48, 55-63, 65 and 71 have been canceled. New claims 86-121 have been added. Thus claims 16, 17, 19-25, 41, 43-47, 49-54, 64, 66-70 and 72-121 are pending.

A terminal disclaimer, relative to the first reissue patent RE37,974E has been received and accepted.

The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178. As the original patent has in fact been surrendered during a prior prosecution, it is respectfully suggested that applicant supply a statement that the original patent has in fact been surrendered and is located in the file wrapper of application Serial No. 09/442,082, the parent application to this Continuation Reissue application. The appropriate form, PTO/SB/55, can be found at our Web site at <http://www.uspto.gov/web/forms/index.html>.

Claim Objections

Claim 16 is objected to because of the following informalities: In line, 7, the recitation "a root end portion" should read -- a root end -- in order to provide the requisite antecedent basis for later recitations of "the root end". There is no further recitations of "a root end portion". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the disclosure fails to enable an embodiment of invention in which there are two "lower housing(s)" as is required by claim 19. (See claim 16, line 11 for initial recitation of "a lower housing").

Claim 90 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the disclosure fails to enable an embodiment of invention in which there are two valve covers, each with a "profiled block" that engages the flexible flap. See also claims 87 and 86 from which claim 90 currently depends.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 89 -121 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japuntich et al. in view of Baldwin.

Claim 90 is included here in view of the dependency being properly from claim 89.

The patent to Japuntich et al. discloses a inhalation filtration mask 12, made of at least one filtration layer 18, adapted to fit over the mouth and nose of a wearer (column 1, lines 56-57, column 2, lines 8-9, etc.). The mask includes an exhalation valve (fig. 3) which includes a self supporting flexible flap 24 mounted in cantilevered fashion to a valve seat generally at 26 (i.e. "upper portion") by pins 40, the flap bending and/or curving upwardly away from a "flat" seat edge 30 of the "upper portion" 26. The "free end" 38 of the flap 24 extends, at all normal orientations of the valve, generally downwardly so as to prevent moisture from exhaled air from rising and condensing on a wearers' eyewear. The cross section of seat edge may take on any shape such as "square, rectangular, circular, elliptical, etc." (column 5, lines 60-65)

Thus the patent to Japuntich et al. discloses all the claimed features with the exception of having a "transverse curvature" imparted to the flexible flap by the mounting of the flap, the "transverse curvature" imposed by a "lower" "cover" member including outlet ports, which "transverse curvature" also imparts closing bias upon the valve to maintain the valve in a closed position.

The patent to Baldwin discloses that it is known in the art to employ, as an exhalation valve for the operator, a flexible flap valve 12 in which the mounting of the valve between an upper seat 11 and "lower" "cover" member 12 imparts a "transverse curvature" to the flap valve (via high point 19; see above re: claims 55, 57, 57, 62 and 66) which "transverse curvature" also imparts a closing bias to the valve to maintain the valve closed in any orientation of the valve (since the valve is closed against the effects

of gravity as shown in fig. 3 of Baldwin it will be closed in any orientation of the valve relative to gravity) for the purpose of relying on the valve being biased closed by the mounting of the valve between the valve seat and a "cover" rather than relying on the natural resiliency of the valve to maintain the valve closed as is the case in Japuntich et al. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ in Japuntich et al. a specific mounting "cover" to mount the flexible flap valve between the seat and "cover" which "cover" imparts a "transverse curvature" to the flap biasing the flap closed for the purpose of relying on the valve being biased closed by the mounting of the valve between the valve seat and a "cover" rather than relying on the natural resiliency of the valve as recognized by Baldwin.

Regarding the claimed "transverse curvature" biasing the valve to a closed position, as disclosed in Baldwin the flexible flap is pinched or retained between opposing housing sections 10, 13. The portion 19 of the support rib 18 is the highest point of the downstream side of the flap 12. The remaining portions/surfaces of the remainder of the support at surface 16 and the downstream periphery of the flap 12 are below point 19 and extend to the plane containing seat 11. Point 19 forms a hinge (column 2, lines 4-20). When assembled, the hinge point 19 presses upwards against the flexible flap at a central point of a chord of the circular flap. Because the surfaces, along the chord at the point 19 leading away from the point 19 in both opposing directions, are lower than the point 19, by reason that this portion of the chord eventually meets the knife edge seat 11, the point 19 imparts a "transverse curvature" to the flap in both a first plane of the flap, left to right as shown in figure 3 along the longitudinal dimension of the flap and a second plane transverse to the first plane, extending into/out of the plane of the figure, forcing the flexible flap beyond the plane of the seat 11.

Looking at this from another perspective, consider a view of the assembled device, from the left in figure 2, looking at the flap along the central rib 18 at the cross section of high point 19. In this view the outer valve seat 11 forms a lowest point of the flap. From the high point 19, the flap extends downwardly and away towards the plane of seat 11. Because the high point 19 is above the plane of the seat 11, there has to be a "transverse curvature" imparted to the once flat flap.

This "transverse curvature" also biases the valve to a closed position (fig. 3) in that, as disclosed, "to move the valve from the knife edge" the operator exhales into conduit 9 and "when the operator stops blowing the disc valve 12 returns to the original position against the knife edge as shown in FIG. 3" (column 2, lines 26-33).

Regarding applicants remarks concerning the "transverse curvature" of Baldwin, the mere allegation that Baldwin does not... show that its flap is curved transversely" is of little or no concern in view of the explanation, repeated above, of just how such a "transverse curvature" is disclosed in Baldwin.

Claim Rejections - 35 USC § 251

The following is a quotation of 35 U.S.C. 251 and 37 CFR. 1.175 which forms the basis for all rejections under 35 U.S.C. § 251 set forth in this Office action:

Reissue of defective patents

35 U.S.C. §251

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue. The Commissioner may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents. The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent. No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

§ 1.175 Reissue oath or declaration

- (a) The reissue oath or declaration in addition to complying with the requirements of 1.63, must also state that:

Art Unit: 3753

- (1) The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue; and
- (2) All errors being corrected in the reissue application up to the time of filing of the oath or declaration under this paragraph arose without any deceptive intention on the part of the applicant.
- (b)(1) For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant. Any supplemental oath or declaration required by this paragraph must be submitted before allowance and may be submitted:
- (i) With any amendment prior to allowance; or
- (ii) In order to overcome a rejection under 35 U.S.C. 251 made by the examiner where it is indicated that the submission of a supplemental oath or declaration as required by this paragraph will overcome the rejection.
- (2) For any error sought to be corrected after allowance, a supplemental oath or declaration must accompany the requested correction stating that the error(s) to be corrected arose without any deceptive intention on the part of the applicant.
- (c) Having once stated an error upon which the reissue is based, as set forth in paragraph (a)(1), unless all errors previously stated in the oath or declaration are no longer being corrected, a subsequent oath or declaration under paragraph (b) of this section need not specifically identify any other error or errors being corrected.
- (d) The oath or declaration required by paragraph (a) of this section may be submitted under the provisions of 1.53(f).
24 FR 10332, Dec. 22, 1959; 29 FR 18503, Dec. 29, 1964; 34 FR 18857, Nov. 26, 1969; para. (a), 47 FR 21752, May 19, 1982, effective July 1, 1982; para. (a), 48 FR 2713, Jan. 20, 1983, effective Feb. 27, 1983; para. (a)(7), 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997.

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

It is noted that all references to applicants Foreign priority application United Kingdom No. 9515986 in all the oaths of record currently list the filing date of this application as "26 July 1996". A review of this foreign application, as filed on the original patent, indicated that this application was filed 04 August 1995. It is respectfully suggested that applicants records and all future oaths be checked for accuracy in regards to this matter.

The reissue oath/declaration fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414. As this application is a Continuation Reissue application, the currently filed oath/declaration lists "errors" correctable by reissue which were in the original patent. These "errors" were then corrected during prosecution of the parent Reissue application Ser. No. 09/442,082 now Reissued Patent RE 37,974. Accordingly, any Reissue oath/declaration filed in a continuation Reissue application must list "errors" allegedly now in the Reissued patent (RE 37,974, Ser. No. 09/442,082). As the original patent

has been surrendered in favor of Reissued Patent RE 37,974, there are in fact no "errors" in the original patent because there now is no "original" patent. The act of filing a Continuing Reissue application presumes there are in fact now "errors" in the Reissued Patent (37,974). In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 16, 17, 19-25, 41, 43-47, 49-54, 64, 66-70 and 72-121 are rejected as being based upon a defective reissue oath under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

and can be found on form PTO/SB/51S also available on the above noted web site.

Claims 16, 17, 19-25, 41, 43-47, 49-54, 64, 66-70 and 72-89 would be allowable pending the outcome of the above rejection based on an insufficient oath or declaration.

Conclusion


Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Rivell whose telephone number is (703) 308-2599. The examiner can normally be reached on Mon.-Thur. from 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Scherbel can be reached on (703) 308-1272. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


John Rivell
Primary Examiner
Art Unit 3753

j.r.